

Appln. No. 09/914,773

Amd. dated December 19, 2005

Reply to Office Action of September 23, 2005

Amendments to the drawings:

The attached drawing sheet includes changes to Fig. 2 and replaces the original sheet containing Fig. 2. The only change in Fig. 2 is replacement of the reference numeral 14 by the reference numeral 14a to distinguish from pin 14 shown in Fig.

1. The specification has been amended to conform to this change.

REMARKS

The Examiner's action dated September 23, 2005, has been received, and its contents carefully noted.

In order to advance prosecution, claim 15 has been canceled, the Specification, drawing and claim 6 have been amended to overcome the rejection under 35 U.S.C. §112, first paragraph and the claims have been amended to overcome the rejection under 35 U.S.C. §112, second paragraph.

The rejection of claims 6-14 under 35 U.S.C. §112, first paragraph is respectfully traversed. It appears that this rejection results from the fact that the reference numeral "14" was erroneously used to identify two different components: a pin shown in Figure 1 and referred to in claim 11; and a moving device shown in Figure 2 and referred to in claim 6. In order to eliminate confusion, submitted herewith is a replacement sheet for Figure 2 that renumbers the moving device with the reference numeral "14a"; the Specification and claim 6 have been amended to contain the revised reference numeral. It should be noted that only the element shown in Figure 2 and originally identified with the reference numeral 14 is a moving device.

In any event, despite the erroneous dual use of the same reference numeral, the fact remains that Figure 2 does illustrate a moving device on a drive frame 12 and this

apparatus is described in the Specification, in the first paragraph on page 7. In view of the amendments made to the drawing, the Specification and claim 6 and the above explanation, it is submitted that the claims in question do comply with the written description requirement and it is therefore requested that this rejection be withdrawn.

Moreover, rejection of claims 8-14 on this ground is clearly inappropriate. The rejection is based solely on recitations that previously appeared in claim 6. Claims 8-14 do not depend, either directly or indirectly, from claim 6 and do not include the limitations on which the rejection was based.

In response to the rejection under 35 U.S.C. §112, second paragraph, the term "RFZ" has been deleted from all of the claims. It might be noted that this term is employed as a reference designation in the Specification and it is understood that the use of such reference characters in the claims is normally considered to be permissible.

The claims have been amended to delete use of the term "receptacle", and to refer consistently to a "fork". It is believed appropriate to note, however, that the previous version of claim 1 specified that the receptacle is formed by a fork and it is submitted that this recitation did indicate the relation between those two terms.

As noted above, claim 15 has been canceled.

In order to overcome the rejection of claim 6 under 35 U.S.C. §112, second paragraph, this claim has been amended to depend from claim 4, which does provide proper antecedent basis for the term "fork frame" and claim 6 has been further amended to refer more consistently to "the horizontal axis (6)".

Claim 7 has been amended by deletion of the phrase that the Examiner finds to lack antecedent basis.

In view of the above, it is requested that the rejection under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

The prior art rejections of the claims, based on new grounds, presented on page 3 of the Action, are also respectfully traversed.

As regards the rejection of claims 1 and 3 as anticipated by Seaberg, claim 1 of the present Application is directed to a shelf stacking machine that includes "a fork for carrying paper reels".

The term "fork" has a clear meaning in normal usage, and an even more specific meaning in the field to which the present invention relates. It is an implement having two arms, or tines, that can be moved under a pallet or cylindrical object whose axis is oriented horizontally in

order to lift the pallet or the object and carry it to a desired location.

The Seaberg patent does not disclose a fork, but rather clamp arms that can be pivoted to grip the sides of an article. Clamp arms do not constitute a fork and the clamp arms disclosed in the reference cannot perform the functions of a fork.

Moreover, claim 1 of the present Application further defines "measuring devices that detect the carrying load of a picked-up paper reel". In the explanation of the rejection, it is asserted that the reference discloses such measuring devices. It is submitted that this conclusion is not justified.

The "measuring devices" disclosed at column 3, lines 45-57 of the reference specification are, in fact, rotation-stopping switches that interact with cams only in order to place the clamp arms in desired positions. Thus, the only detection performed by these devices relates to the orientation of the clamp arms and is neither intended to nor capable of detecting the carrying load of a picked-up paper reel.

As disclosed at column 3, lines 40-57 of the reference, the switches and cams are part of an automatic rotation control system and it is clear that the operation of

this control system is independent of the presence or absence of a load being carried by the clamp arms.

The rejection of claim 2 is traversed at least for the reason that this claim depends from claim 1 and should be considered allowable alongtherewith. Since the system disclosed by Seaberg is not intended to detect a load being carried by a fork, one skilled in the art would have absolutely no reason to incorporate the ultrasound sensors of Lanza in the apparatus of Seaberg.

The rejection of claims 1 and 3-5 as unpatentable over Broersma in view of Seaberg isalso respectfully traversed.

Like Seaberg, Broersma does not disclose a machine provided with a fork. Rather, this machine, like Seaberg, is equipped with clamp arms that do not perform the functions of a fork. Indeed, the specification of this patent clearly discloses that the object of the invention is to provide an attachment for gripping various types of loads; a fork does not grip a load.

In the explanation of this rejection, the Examiner acknowledges that Broersma does not disclose sensors and asserts that this deficiency is supplied by Seaberg.

It has already been pointed out above that Seaberg does not disclose "measuring devices that detect the carrying

load of a picked-up paper reel". Therefore, even if the reference teachings were combined, the machine defined in claim 1 would not result.

Claims 3-5 further define patentably over the applied references by their recitations of specific structural features of the fork. Since neither of the references discloses a fork, it is clear that neither of them discloses the features defined in claims 3-5.

The Office Action does not treat claims 6-14 on the basis of the prior art because claim 6 was considered to be unclear. However, as noted above, claims 8-15 did not depend from, or include the limitations of, claim 6. Therefore, no proper reason was stated for refusing to consider claims 8-14 on the merits.

Request for Withdrawal of Finality of Action

If the present Amendment is not found to place the Application in allowable condition, then it is requested that the finality of the rejection presented in the last Office Action as premature. The reasons why the finality of the rejection must be withdrawn are the following:

- 1) The Office Action contains, for the first time, a rejection of claims under 35 U.S.C. §112, first paragraph. The amendments made to claims 6-14 could not possibly have necessitated this new ground of rejection.

Indeed, claim 6 was previously amended only to change its dependency in response to a rejection thereof under 35 U.S.C. §112, second paragraph. The substance of claim 6, and particularly the recitations relating to the moving device, were not changed by the previous Amendment.

A second Action should not be made final if it includes a rejection on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. MPEP §706.07(a). In the present case, it certainly would be expected that claim 6 would be amended to overcome the previous rejection relating to lack of antecedent basis and a redundant recitation. Clearly, the substance of claim 6 was not changed.

2) As already noted above, claims 8-14 were not examined on the merits and no proper reason for refusing to examine those claims on the merits was presented.

3) The amendments to claim 1 could not properly be considered to necessitate a new ground of rejection based on newly cited art. Clearly, the amendments to claim 1 were for the purpose of overcoming previous formal rejections and to otherwise place the claim in better form. The major amendment to claim 1 simply served to assure that the actuator, which was an element of the original claim, would be considered to be positively recited. It is clear

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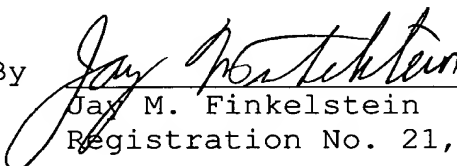
from the rejection presented in the Office Action of December 7, 2004, that the Examiner treated the original version of claim 1 as defining such an actuator.

In view of the foregoing, it is requested that all of the rejections presented in the last Office Action be reconsidered and withdrawn and that the Application be found in allowable condition. Alternatively, it is requested that the finality of the rejections presented in the previous Action be withdrawn, that the present Amendment be entered and that an Action be given on the merits of all of the pending claims.

If the above amendment should not now place the application in condition for allowance, the Examiner is invited to call undersigned counsel to resolve any remaining issues.

Respectfully submitted,

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